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U.S. DEPARTMENT OF COMMERCE
PATENT AND TRADEMARK OFFICE

**APPEAL BRIEF TRANSMITTAL &
REQUEST FOR EXTENSION OF TIME**

Docket Number:
10191/1833

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Application Number
09/857,677

Filing Date
October 16, 2001

Examiner
Nhan T. LE

Art Unit
2685

Invention Title
**TELECOMMUNICATION TERMINAL
HAVING CHARACTER RECOGNITION**

Inventor
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Date: January 25, 2006


Reg. No. 36,197

Signature: _____

Jong H. Lee

Further to the Notice of Appeal dated August 22, 2005 (filed at the PTO on August 25, 2005) for the above-referenced application, enclosed are three copies of an Appeal Brief. Accompanying the Appeal Brief is the Appendix to the Appeal Brief. A three-month extension of time for filing the Appeal Brief is requested.

The Commissioner is hereby authorized to charge payment of the 37 C.F.R. § 41.20(b)(2) appeal brief filing fee of **\$500.00**, as well as **\$1,020** fee for a three-month extension of time for filing the Appeal Brief, and any additional fees associated with this communication to the deposit account of **KENYON & KENYON LLP**, deposit account number **11-0600**.

 (R. NO. 36,197)

Dated: January 25, 2006

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[10191/1833]

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BOARD OF PATENT APPEALS AND INTERFERENCES**

Applicant : Joerg-Michael HASEMANN
Application No. : 09/857,677
Filed : October 16, 2001
For : TELECOMMUNICATION TERMINAL HAVING
CHARACTER RECOGNITION

Art Unit : 2685
Examiner : Nhan T. LE
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**APPENDIX TO APPELLANT'S APPEAL BRIEF
UNDER 37 C.F.R. § 41.37**

I. CLAIMS APPENDIX

The claims involved in this appeal, claims 12-29, in their current form after entry of all amendments presented during the course of prosecution, are set forth below:

12. An integrated telecommunication terminal in a single integrated housing, comprising:

 a plurality of data input units including at least one pressure sensor element;

 a character recognition unit;

 a pressure receiving element acting jointly with the at least one pressure sensor element so that a movement of the pressure receiving element on a

surface is detectable by the at least one pressure sensor element, the movement of the pressure receiving element detected by the at least one pressure sensor element being converted into signaling information by the character recognition unit in the single integrated housing, and the surface is able to be written upon by the movement of the pressure receiving element;

wherein the plurality of data input units include a plurality of confirmation devices, and the signaling information is correctable by the plurality of confirmation devices.

13. The telecommunication terminal according to claim 12, wherein:
the character recognition unit recognizes alphanumeric characters.
14. The telecommunication terminal according to claim 12, further comprising:
a transmitting unit via which a signal can be dispatched in dependence on the signaling information.
15. The telecommunication terminal according to claim 12, further comprising:
a plurality of reproduction devices, wherein:
the signaling information is representable by the plurality of reproduction devices.
16. The telecommunication terminal according to claim 15, wherein:
the plurality of confirmation devices includes a plurality of keys.
17. The telecommunication terminal according to claim 15, wherein:
the signaling information is representable by the plurality of reproduction devices in accordance with at least one of an optical form and an acoustic form.
18. The telecommunication terminal according to claim 12, wherein:
the pressure receiving element includes a writing tip.
19. The telecommunication terminal according to claim 12, wherein:
an input function and an operating function can be activated in dependence on the signaling information according to a menu-driven operation.

20. The telecommunication terminal according to claim 12, wherein:
in dependence upon the signaling information, a radio mode can be activated and operated.
21. The telecommunication terminal according to claim 20, wherein:
the radio mode is for at least one of a voice communication and for an exchange of brief messages.
22. The telecommunication terminal according to claim 21, wherein:
the brief messages include SMS messages.
23. The telecommunication terminal according to claim 20, wherein:
the radio mode can be activated and operated for an input of telephone numbers.
24. The telecommunication terminal according to claim 12, wherein:
in dependence upon the signaling information, a memory mode can be activated and operated.
25. The telecommunication terminal according to claim 24, wherein:
the memory mode can be activated and operated for entering at least one of a telephone entry and a notebook entry into a memory.
26. The telecommunication terminal according to claim 15, wherein:
in dependence upon the signaling information, a calculator mode can be activated and operated, and
the signaling information is processable and calculation results are displayable in accordance with an operation of the plurality of reproduction devices.
27. The telecommunication terminal according to claim 12, wherein:
in dependence upon the signaling information, an alarm clock mode can be activated and operated.
28. The telecommunication terminal according to claim 12, further comprising:
a data interface for transmitting data.

29. The telecommunication terminal according to claim 28, wherein:
the data interface includes an infrared interface.

II. EVIDENCE APPENDIX

In the present application, there has been no evidence submitted pursuant to 37 C.F.R. §§ 1.130, 1.131 or 1.131, or other evidence entered by the Examiner and relied upon by Appellants in the present appeal.

III. RELATED PROCEEDINGS APPENDIX

No appeal or interference which will directly affect, or be directly affected by, or have a bearing on, the Board's decision in the pending appeal is known to exist.

Respectfully submitted,

KENYON & KENYON LLP

 (R.No. 36,197)

Dated: January 25, 2006

By: JONG LEE for Gerard Messina

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PATENT & TRADEMARK OFFICE



**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
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Applicant : Joerg-Michael HASEMANN
Application. No. : 09/857,677
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APPELLANT'S APPEAL BRIEF
UNDER 37 C.F.R. § 41.37

S I R :

Applicant filed a Notice of Appeal dated August 22, 2005 (filed at the PTO on August 25, 2005), appealing from the Final Office Action dated February 23, 2005, in which claims 12-29 of the above-identified application were finally rejected. This Brief is submitted by Applicant in support of his appeal.

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I. REAL PARTY IN INTEREST

The real party in interest in the present appeal is Robert Bosch GmbH of Stuttgart, Germany. Robert Bosch GmbH is the assignee of the entire right, title, and interest in the present application.

II. RELATED APPEALS AND INTERFERENCES

No appeal or interference which will directly affect, or be directly affected by, or have a bearing on, the Board's decision in the pending appeal is known to exist to the undersigned attorney or is believed by the undersigned attorney to be known to exist to Applicant.

III. STATUS OF CLAIMS

Claims 12-29 are pending in this application and are being appealed. Claims 1-11 have been canceled. Amongst the pending claims, claim 12 is independent, and claims 13-29 are ultimately dependent on claim 12.

IV. STATUS OF AMENDMENTS

Subsequent to the final Office Action mailed on February 23, 2005, Applicant submitted "Rule 116 Amendment" (mailed on August 4, 2005), in which amended Figures 1-6 containing descriptive labels for the boxes were presented. In the Advisory Action mailed on October 28, 2005, the Examiner did not indicate whether amended Figures 1-6 were entered.

V. SUMMARY OF THE CLAIMED SUBJECT MATTER

The telecommunication terminal 10 shown in Fig. 1 includes: data input devices 140 and reproduction devices 120, both connected to a control device 190; a transmitting device 160 and a receiving device 180, which are also both connected to a controlling device 190; and a memory 192 is assigned to the control device. (Substitute Specification, P. 3, l. 18-30). In addition, a data interface may be optionally provided, which permits the exchange of data between the telecommunication terminal 10 and a further unit, such as a

second telecommunication terminal 10 or even a data processing installation. (P. 3, l. 24-27).

As shown in Figure 2, the telecommunication terminal 10 includes: a housing 100; a pressure receiving element 220; a first pressure sensor element 201; a second pressure sensor element 202; and a third pressure sensor element 203. (P. 3, l. 32 – p. 4, l. 4). The pressure receiving element 220 transmits the forces exerted by the surface to the pressure sensor elements 201, 202, and 203, which are particularly positioned in such a way that the pressure receiving element 220 transmits at any one time a component of the movement to one of the pressure sensor elements 201, 202, 203. (P. 4, l. 6-10). Thereby, movements on a surface, such as on a sheet of paper, are detected in such a way that a movement of the telecommunication terminal 10 in a first movement direction on the surface is detectable either exclusively by the first pressure sensor element 201 or, in a first circumstance, by the first and the second pressure sensor element 201, 202, and that a movement of the telecommunication terminal 10 in a second movement direction, which is rotated with respect to the first movement direction by an angle, e.g., 90°, is detectable either exclusively by the second pressure sensor element 202 or, in a second circumstance, by the first and the second pressure sensor elements 201, 202; a pressing of the telecommunication terminal 10 upon the surface is detectable by the third pressure sensor element 203. (P. 4, l. 13-23).

A second end of the pressure receiving element 220, lying opposite to the first end, is designed as a writing tip 222, for instance, in the form of a ballpoint tip or the like, and this makes it possible to note down the movements the telecommunication terminal 10 makes in, for instance, drawing a picture on the surface, whereby a written character is then visible on the surface, e.g., on a paper surface or the like, which makes possible a secure and checked data input. (P. 4, l. 26-31). At a second end of the pressure receiving element 220, the pressure sensor elements 201, 202, 203 pick up the forces impinging upon the writing tip 222 and transmitted by the pressure receiving element 220. (P.

5, l. 2-5). In an exemplary embodiment, the telecommunication terminal 10 is formed, for instance as a ballpoint pen, pencil, or the like. (P. 5, l. 5-6).

The reproduction devices 120 include an indicator element 122, such as an LCD display, and a receiver inset 124; the input devices 140 include confirmation devices 142, e.g., keys, and a microphone 144. (P. 5, l. 18-20).

As shown in Figure 5, which is a flowchart for character recognition in the telecommunication terminal 10, the pressure sensor elements 201, 202, 203 transduce the force data 500 into signals 520, and the pressure sensor elements 201, 202, 203, which are connected to a character recognition unit 240, conduct the signals 520 further on to the character recognition unit 240, which converts the signals 520 into character data 550. (P. 6, l. 26 – p. 7, l. 1).

As shown in Figure 6, which is a block diagram illustrating conversion of the signal information 520 into character data 550, the character recognition unit 240 includes: a digital-analog conversion unit 241, which is connected to a central unit 244; a standardizing unit 242 and a recognition unit 243, which are also connected to the central unit 244. (P. 7, l. 3-6). The central unit 244 is also connected to the confirmation devices 142. (P. 7, l. 6-7).

By use of the confirmation devices 142 it is possible to have an influence on the recognition of the first characters in the recognition unit 243: using a first correction feature, an erroneously recognized first character can be replaced by a second character from the set of possible first characters; using a second correction feature, a completely new third character, that is to be recognized, can be input, if necessary, after repeated but fruitless use of the first correction feature, by executing a movement on the surface which corresponds to the third character, using the telecommunication terminal. (P. 7, l. 25-31).

The signaling information 550 recognized by the character recognition unit 240 is conducted to the control unit 190 for controlling the

telecommunication terminal 10. (P. 8, l. 1-2). In dependence upon the signaling information 550, the control unit activates the reproduction devices 120, the transmitting device 160 and/or the receiving device 180. (P. 8, l. 4-5). In Figure 2, the display element 122 and the receiver inset 124 are described as examples of optical or acoustical reproduction devices 120, respectively; however, reproduction devices 120 can be provided whose reproduction effect is made accessible to the user by sense of touch, and which can thus be viewed as haptic reproduction devices 120, e.g., vibration devices for signaling such as incoming telephone calls. (P. 8, l. 4-10).

For checking the correctness of the signaling information 550 by the user, the signaling information 550 can be displayed on the display element 122, and results of calculating operations can be displayed on the display element 122. (P. 8, l. 18-20). Acoustical signals can be made audible by the receiver inset 124, for correcting, for example, the data input by movements of the telecommunication terminal 10 on a surface. (P. 8, l. 23-25).

In an example embodiment of the telecommunication terminal 10, the memory 192 assigned to control unit 190 has contents for the menu-driven control of the telecommunication terminal 10, particularly data on various menu points and their pertaining control commands. (P. 9, l. 14-17). Menu contents and their representation on the reproduction devices 120, particularly on the display element 122, can be provided permanently stored and invariable and/or programmable and changeable. (P. 9, l. 17-19).

In a further example embodiment of the telecommunication terminal 10, the transmitting unit 160 and the receiving unit 180 are designed in such a way that wireless communication, e.g., according to the GSM standard, can be operated. (P. 9, l. 23-25). The telecommunication terminal 10 can be operated for voice communication and/or for exchanging short messages, e.g., SMS messages. (P. 9, l. 25-27).

In another example embodiment, the telecommunication terminal 10 includes a calculating unit assigned to the control unit 190, with which calculating operations can be carried out in a calculating mode of the telecommunication terminal 10. (P. 10, l. 1-3).

In still another example embodiment, the telecommunications terminal 10 includes a clock which acts together with the memory 192, assigned to the control unit 190, in such a way that functions of the telecommunication terminal 10 can be activated in dependence upon third data at predetermined points in time, such as stored appointment times or alarm clock times. (P. 10, l. 5-8).

VI. GROUNDS OF REJECTION TO BE REVIEWED ON APPEAL

The following grounds of rejection are presented for review on appeal in this case:

(A) Whether pending claims 12-25 and 27-29 are unpatentable under 35 U.S.C. § 103(a) over U.S. Patent 6,487,421 ("Hess") in view of U.S. Patent 6,081,261 ("Wolff") and further in view of U.S. Patent 4,751,741 ("Mochinaga").

(B) Whether claim 26 is obvious under 35 U.S.C. § 103(a) over Hess in view of Wolff and Mochinaga, and further in view of U.S. Patent No. 6,104,388 to Nagai et al. ("Nagai").

VII. ARGUMENTS

A. REJECTION OF CLAIMS 12-25 & 27-29 UNDER 35 U.S.C. § 103

Claims 12-25 and 27-29 were rejected under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent 6,487,421 to Hess et al. ("Hess") in view of U.S. Patent 6,081,261 to Wolff et al. ("Wolff") and further in view of U.S. Patent 4,751,741 to Mochinaga et al. ("Mochinaga"). Applicant respectfully submits that this rejection should be reversed for at least the following reasons.

In rejecting a claim under 35 U.S.C. § 103(a), the Examiner bears the initial burden of presenting a prima facie case of obviousness. In re Rijckaert, 9 F.3d 1531, 1532, 28 U.S.P.Q.2d 1955, 1956 (Fed. Cir. 1993). To establish prima facie obviousness, three criteria must be satisfied. First, there must be some suggestion or motivation to modify or combine reference teachings. In re Fine, 837 F.2d 1071, 5 U.S.P.Q.2d 1596 (Fed. Cir. 1988). This teaching or suggestion to make the claimed combination must be found in the prior art and not based on the application disclosure. In re Vaeck, 947 F.2d 488, 20 U.S.P.Q.2d 1438 (Fed. Cir. 1991). Second, there must be a reasonable expectation of success. In re Merck & Co., 800 F.2d 1091, 231 U.S.P.Q. 375 (Fed. Cir. 1986). Third, the prior art reference(s) must teach or suggest all of the claim limitations. In re Royka, 490 F.2d 981, 180 U.S.P.Q. 580 (C.C.P.A. 1974). Not only must the cited references teach or suggest each element of the claim, but the prior art must also suggest the desirability of combining the elements in the manner contemplated by the claim. M.P.E.P. § 2143.01 (citing In re Mills, 916 F.2d 680, 16 U.S.P.Q.2d 1430 (Fed. Cir. 1990)). The mere fact that references can be combined or modified does not render the resultant combination obvious unless the prior art also suggests the desirability of the combination. In re Mills, 916 F.2d 680, 16 U.S.P.Q.2d 1430 (Fed. Cir. 1990).

Independent claim 12 recites “an **integrated telecommunication terminal in a single integrated housing**” including “a character recognition unit” and “a pressure receiving element,” with “the movement of the pressure receiving element detected by the at least one pressure sensor element being **converted into signaling information by the character recognition unit in the single integrated housing.**” In support of the obviousness rejection, the Examiner merely lists what each applied reference teaches, i.e., Hess as teaching a telecommunication terminal having a plurality of data input units and a character recognition; Wolff as teaching a data input unit including a pressure sensor element and a pressure receiving element acting jointly with the pressure sensor element such that the movement of the pressure receiving element detected by the at least one pressure sensor element is convertible into

signaling information by the character recognition unit; and Mochinaga as teaching “the character recognition unit and the pressure receiving unit, wherein the movement of the pressure receiving element detected by the at least one pressure sensor element is converted into signaling information by the character recognition unit in the single integrated housing.” (Final Office Action, p. 4; Advisory Action, p. 2-3). Based on these assertions, the Examiner summarily concludes the following:

The combination of Hess, Wolff and Mochinaga also discloses one confirmation device. In conclusion, the applied reference teaches an integrated telecommunication terminal in a single integrated housing of claim 12. In response to applicant's argument that the Examiner's conclusion of obviousness is based upon improper hindsight reasoning, it must be recognized that any judgment on obviousness is in a sense necessarily a reconstruction based upon hindsight reasoning. But so long as it takes into account only knowledge which was within the level of ordinary skill at the time the claimed invention was made, and does not include knowledge gleaned only from the applicant's disclosure, such a reconstruction is proper. (Advisory Action, p. 3).

While the Examiner recites the selective teachings of the applied prior art that the Examiner wishes to apply against Applicant's claim 12, the Examiner's asserted “rationales” for combining the selective teachings of the applied prior art do not actually support the obviousness conclusion. The Examiner provides the following assertions as the supporting “rationales” for making the combination: a) “it would have been obvious to . . . provide the teachings of Wolff into the device of Hess for recognizing when a written entry is made on a page”; and b) “it would have been obvious to . . . provide the teaching of Mochinaga into the device of Hess and Wolf so that the input signals can be corrected by the users.” (Final Office Action, p. 4). Furthermore, although the Examiner concedes that the “combination of Hess, Wolff and Mochinaga discloses one confirmation device,” the Examiner concludes that “it would have been obvious to . . . replace a confirmation device 8 with a plurality of confirmation devices 8 . . . because input signals could be quickly corrected.”

(Final Office Action, p. 4-5). Applicant notes that the Examiner has merely listed what each applied reference allegedly teaches, but the Examiner has not provided any *objective* evidence that the applied prior art actually suggests any rationale or motivation for combining the elements in the manner contemplated by claim 12.

In rejecting a claim under 35 U.S.C. § 103(a), Applicant's invention "must be viewed not with the blueprint drawn by the inventor, but in the state of the art *that existed at the time*." See Interconnect Planning Corp. v. Feil, 774 F.2d 1132, 1138, 227 U.S.P.Q. 543, 547 (Fed. Cir. 1985) (emphasis added). The Federal Circuit has clearly indicated in the case of In re Kotzab that even if a claim concerns a "technologically simple concept" -- which is not the case here --, there still must be some finding as to the "specific understanding or principle within the knowledge of a skilled artisan" that would motivate a person having no knowledge of the claimed subject matter to "make the combination in the manner claimed." In re Kotzab, 55 U.S.P.Q.2d 1313, 1318 (Fed. Cir. 2000). Moreover, the Federal Circuit in the case of In re Kotzab made clear that even if a claim concerns a "technologically simple concept" -- which is not the case here --, there still must be some finding as to the "specific understanding or principle within the knowledge of a skilled artisan" that would motivate a person having no knowledge of the claimed subject matter to "make the combination in the manner claimed." In addition, a *prima facie* finding of obviousness requires a suggestion to combine the references that is "clear and particular." In re Dembiczak, 50 U.S.P.Q.2d 1614 (Fed. Cir. 1999).

While one may argue that the combination asserted by the Examiner may be possible, the teachings of the three applied references do not provide any objective motivation for selectively combining the individual teachings in the manner suggested by the Examiner, particularly since the three applied references relate to completely disparate technical systems, and each individual selected teaching would have to be taken out of context in order to

make the combination asserted by the Examiner. In this regard, Hess teaches a **mobile radio telephone** that includes a motion detector for enabling input of graphic information (e.g., letters and digits), as well as a recognition device for character recognition; Wolff teaches a **pen-like instrument** for making written entries (as well as reading written data) and sensing the forces exerted on the writing tip, as well as the motion of the writing tip, but the processing of the data from the pen-like instrument is performed in a separate base unit 92 (see, col. 9, l. 21-27); and Mochinaga teaches a pen-type character recognition device having a single correction device. In order to make the selective combination asserted by the Examiner, starting with the teachings of Hess, one of ordinary skill in the art would have to initially overlook the fact neither Wolff nor Mochinaga relates to a telecommunication device. In addition, one of ordinary skill in the art has to selectively incorporate into the system of Hess the teachings of Wolff regarding a pressure sensor element and a pressure receiving element, despite the fact that there is clearly no motivation for such incorporation since the switch device and the motion sensor or Hess fully satisfy the needs of the Hess system, and such incorporation would completely change the principle of operation of Hess and/or render the system of Hess unsatisfactory for its original intended purpose, thereby rendering the obviousness conclusion incorrect as a matter of law. MPEP 2143.01 (citing In re Gordon, 733 F.2d 900, 221 U.S.P.Q. 1125 (Fed. Cir. 1984), and In re Ratti, 270 F.2d 810, 123 U.S.P.Q. 349 (C.C.P.A. 1959)). The rationale for making the asserted combination is further attenuated by the fact that one of ordinary skill in the art would have to selectively incorporate the correction device of Mochinaga into the combined system of Hess and Wolff, for which incorporation there is no clear suggestion. Since a *prima facie* finding of obviousness requires a suggestion to combine the references that is “clear and particular,” and since the Examiner has not provided any “clear and particular” suggestion for the combination, the Examiner has not established a *prima facie* finding of obviousness. See In re Dembiczak, 50 U.S.P.Q.2d 1614 (Fed. Cir. 1999).

Applicant respectfully submits that, without the teachings of Applicant, one of ordinary skill in the art simply would not be motivated to make the selective combination asserted by the Examiner, which means the Examiner's asserted combination is based on impermissible hindsight reconstruction. To the extent the Examiner argues in the Advisory Action that the hindsight reconstruction is proper because the Examiner's reconstruction "takes into account only knowledge which was within the level of ordinary skill at the time the claimed invention was made," even if one assumes for the sake of argument that the Examiner is not relying on the teachings of Applicant, the Examiner's asserted combination is essentially based on an "obvious-to-try" rationale, which is legally insufficient to support a *prima facie* obviousness: the mere fact that references *can* be combined or modified does not render the resultant combination obvious *unless* the prior art also suggests the desirability of the combination. In re Mills, 916 F.2d 680, 16 U.S.P.Q.2d 1430 (Fed. Cir. 1990). The Examiner's evidence of "knowledge which was within the level of ordinary skill at the time the claimed invention was made," is limited to the prior art references applied in support of the rejection, and the applied references simply do not support the asserted combination. With respect to the subjective "obvious-to-try" standard, the cases of In re Fine, 5 U.S.P.Q.2d 1596 (Fed. Cir. 1988), and In re Jones, 21 U.S.P.Q.2d 1941 (Fed. Cir. 1992), clearly indicate that the Examiner's generalized assertions, i.e., it would have been obvious to combine or modify the references relied upon, do not properly support an obviousness rejection. In particular, the Court in the case of In re Fine stated: "One cannot use hindsight reconstruction to **pick and choose among isolated disclosures in the prior art to deprecate the claimed invention.**" In re Fine, 5 U.S.P.Q.2d at 1600 (citations omitted; emphasis added). Likewise, the Court in the case of In re Jones stated that:

Before the PTO may combine the disclosures of two or more prior art references in order to establish prima facie obviousness, there must be some suggestion for doing so, found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art. . . .

Conspicuously missing from this record is any evidence, other than the PTO's speculation (if it be called evidence) that one of ordinary skill . . . would have been motivated to make the modifications . . . necessary to arrive at the claimed [invention].

In re Jones, 21 U.S.P.Q.2d at 1943 & 1944 (citations omitted).

Applicant notes that the Examiner has offered no evidence whatsoever of actual suggestion in the applied prior art to make the asserted modification, but only conclusory hindsight, reconstruction and speculation. Since the Examiner's asserted combination of Hess, Wolff and Mochinaga is based on *improper* hindsight reconstruction, rather than based on a suggestion from the prior art that is "clear and particular," the obviousness rejection of claim 12 is improper. See In re Dembiczak, 50 U.S.P.Q.2d 1614 (Fed. Cir. 1999).

For the reasons discussed above, claim 12 and its dependent claims 13-25 and 27-29 are not rendered obvious by the combination of Hess, Wolff, and Mochinaga. Accordingly, reversal of the obviousness rejection under 35 U.S.C. § 103(a) with respect to claims 12-25 and 27-29 is hereby respectfully requested.

B. REJECTION OF CLAIM 26 UNDER 35 U.S.C. § 103

Claim 26 stands rejected under 35 U.S.C. § 103(a) as being obvious over Hess in view of Wolff and Mochinaga, and further in view of U.S. Patent No. 6,104,388 to Nagai et al. ("Nagai").

In rejecting a claim under 35 U.S.C. § 103(a), the Examiner bears the initial burden of presenting a prima facie case of obviousness. In re Rijckaert, 9 F.3d 1531, 1532, 28 U.S.P.Q.2d 1955, 1956 (Fed. Cir. 1993). To establish prima facie obviousness, three criteria must be satisfied. First, there must be some suggestion or motivation to modify or combine reference teachings. In re Fine, 837 F.2d 1071, 5 U.S.P.Q.2d 1596 (Fed. Cir. 1988). This teaching or suggestion to make the claimed combination must be found in the

prior art and not based on the application disclosure. In re Vaeck, 947 F.2d 488, 20 U.S.P.Q.2d 1438 (Fed. Cir. 1991). Second, there must be a reasonable expectation of success. In re Merck & Co., 800 F.2d 1091, 231 U.S.P.Q. 375 (Fed. Cir. 1986). Third, the prior art reference(s) must teach or suggest all of the claim limitations. In re Royka, 490 F.2d 981, 180 U.S.P.Q. 580 (C.C.P.A. 1974). Not only must the cited references teach or suggest each element of the claim, but the prior art must also suggest the desirability of combining the elements in the manner contemplated by the claim. M.P.E.P. § 2143.01 (citing In re Mills, 916 F.2d 680, 16 U.S.P.Q.2d 1430 (Fed. Cir. 1990)). The mere fact that references can be combined or modified does not render the resultant combination obvious unless the prior art also suggests the desirability of the combination. In re Mills, 916 F.2d 680, 16 U.S.P.Q.2d 1430 (Fed. Cir. 1990).

Claim 26 ultimately depends from claim 12. As discussed in connection with base claim 12, the overall teachings of Hess, Wolff and Mochinaga references do not provide any objective motivation for selectively combining the individual teachings in the manner suggested by the Examiner, particularly since the three applied references relate to completely disparate technical systems, and each individual selected teaching would have to be taken out of context in order to make the combination asserted by the Examiner. In fact, there is clearly no motivation for such incorporation since the switch device and the motion sensor or Hess fully satisfy the needs of the Hess system, and such incorporation would completely change the principle of operation of Hess and/or render the system of Hess unsatisfactory for its original intended purpose, thereby rendering the obviousness conclusion incorrect as a matter of law. MPEP 2143.01 (citing In re Gordon, 733 F.2d 900, 221 U.S.P.Q. 1125 (Fed. Cir. 1984), and In re Ratti, 270 F.2d 810, 123 U.S.P.Q. 349 (C.C.P.A. 1959)). The rationale for making the asserted combination is further attenuated by the fact that one of ordinary skill in the art would have to selectively incorporate the correction device of Mochinaga into the combined system of Hess and Wolff, for which incorporation there is no clear suggestion. Furthermore, Nagai clearly fails to remedy the deficiencies of the combination of

Hess, Wolff and Mochinaga as applied against base claim 12, i.e., the overall teachings of Hess, Wolff, Mochinaga and Nagai do not provide any objective motivation for making the selective combination asserted by the Examiner. Since a *prima facie* finding of obviousness requires a suggestion to combine the references that is "clear and particular," and since the Examiner has not provided any "clear and particular" suggestion for the asserted combination, the Examiner has not established a *prima facie* finding of obviousness. See In re Dembiczak, 50 U.S.P.Q.2d 1614 (Fed. Cir. 1999).

For at least the foregoing reasons, dependent claim 26 is not rendered obvious by the combination of Hess, Wolff, Mochinaga and Nagai. Reversal of the obviousness rejection of claim 26 is respectfully requested.

VIII. CONCLUSION

For the foregoing reasons, it is respectfully submitted that the final rejection of claims 12-29 should be reversed.

Respectfully submitted,

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 (P. No. 36,197)

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